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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/604,843 | 08/21/2003 | Jeremy E. MORIN | | 1842 |
| 23699 | 7590 | 06/02/2005 | | |
| CLAUSEN MILLER, P.C. SUITE 1600 10S. LASALLE STREET CHICAGO, IL 60603 | | | EXAMINER | HARAN, JOHN T |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1733 | |

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/604,843 | MORIN ET AL. |
| | Examiner | Art Unit |
| | John T. Haran | 1733 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/17/03, 11/21/03.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 11/17/03 and 11/21/03 have been considered by the examiner.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: actually forming the paperboard.

Claim 1 should be amended to read --allowing the adhesive to harden , thereby affixing the overlapped sheets together --.

Claim 5 should be amended to read -- affixing one sheet to the other by arranging the sheets into an overlapping relationship and exposing the RF adhesive impregnated sheet to RF energy --.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,783,623.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 6 of the patent read on claims 1 and 5 of the application except they do not specify that the RF active adhesive is a silicate. However, the patent does state that any suitable RF active adhesive can be used (Column 3, lines 15-16) and it is well known and conventional to have RF active silicate adhesives. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a conventional RF active adhesive, such as a silicate, in the method of the patent.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Riebel et al (U.S. Patent 5,611,882) teaches making board stock by mixing an RF active adhesive binder in with pulp stock and then curing the mixture with radio frequency energy (See abstract; Column 2, lines 50-59; Column 10, lines 36-49; Column 11, lines 14-37). The RF active adhesive acts as a binder to bind the pulp together and there is no suggestion that the adhesive impregnated in the board is used to affix together overlapping sheets of similar board stock with or without the RF adhesive mixed therein.

Thomas et al (US 2003/0034117) teaches applying an aqueous-based adhesive coating to paperboard and forming a multiply core or tubular container wherein the adhesive affixes overlapping regions of one or more sheets together. The process uses RF energy to heat the aqueous adhesive to evaporate the water to allow for faster setting of the adhesive (paragraphs 0008-0010 and 0026-0027). There is no suggestion of adding a radio frequency active adhesive into the pulp stock to form a sheet and using the adhesive impregnated in the sheet to affix together overlapping sheets of similar board stock with or without the RF adhesive mixed therein.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John T. Haran whose telephone number is (571) 272-1217. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John T. Haran
Examiner
Art Unit 1733